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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/765,954	01/29/2004	Sung-hee Hwang	1793.1164	2323
49455	7590	01/09/2009	EXAMINER	
STEIN, MCEWEN & BUI, LLP			DINH, TAN X	
1400 EYE STREET, NW				
SUITE 300			ART UNIT	PAPER NUMBER
WASHINGTON, DC 20005			2627	
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			01/09/2009	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/765,954	<b>Applicant(s)</b> HWANG ET AL.	
	<b>Examiner</b> TAN X. DINH	<b>Art Unit</b> 2627	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 October 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) \_\_\_\_\_ is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,4,5 and 22-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

1) The restriction requirement mailed on **12/12/2008** is an error and vacated. This restriction requirement is written for **S/N 11/589,042** ( claims 1-17 ) not for this particular application, the error occurs by typing from examiner. The following is new ground of the rejection.

2) The amendment/preliminary amendment filed **10/14/2008** is acknowledged.

3) Claims **1,4,522,23 and 24** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase “ location information ” ( claims 1 and 22 ) is unclear and cannot be understood. The “ location information ” of what ?.

The phrase of “ which updated predetermined information ” ( claims 1 and 22 ) is unclear and cannot be understood. Is this “ updated predetermined information ” indicates for position information of a defective area, position information of a replacement area, location information, etc., ?.

Claim(s) **4,5,23 and 24** incorporate the indefiniteness of claim(s) 1 and 22 by virtue of their dependency thereon.

4) The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ 2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ 2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed **Terminal Disclaimer** in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective **January 1, 1994**, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with **37 CFR 3.73(b)**.

The double patent rejections in last Office action is repeated herein.

5) Claims *1 and 22* are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over independent claims of copending Application No.

- 12/173,341.

- 12/113,398.

- 12/116,279.

- 12/116,436.

- 12/035,721.

- 12/035,700.

- 12/039,969.

- 11/976,101.

- 11/968,740.

- 11/866,622.

- 11/852,700.

- 11/430,084.

Although the conflicting claims are not identical, they are not patentably distinct from each other because:

The independent claims in those applicants list above discloses all the subject matters as claimed in claims 1 and 22 of this instant application, such as, an optical disc and/or optical recording/reproducing method/apparatus having temporary defective

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management information comprises position information on defective area and position information on replacement area for replacing the defected area, *except* an access information and the physical/logical address of location information. However, these different is not a patentable weight since the body of these claims recite the same structures and/or functions with each other and this would not make them a patentable distinction.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

6) The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7) This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C.103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention

dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8) Claims 1,4,5 and 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over SHIN( 6,529,458 ) further in view of TAKAHASHI ( US 2002/0150010 ).

SHIN discloses an optical disc with at least one record layer as claimed in claim 1, comprises at least one temporary defective management area in which temporary defect information and temporary defect management information are recorded, the temporary defect management information comprises pointer indicating an area in which the temporary defect information is recorded ( Fig.5, defective management area, DMA1, DMA2, DMA3, DMA4. Figure 6, step 607 write data on defective area at position the write command designated ), an access information area in which location information regarding an area in which the updated predetermined information is recorded, is recorded ( Fig.5 LIA, data area and LOA are all access information areas ), wherein the location information comprises a physical or logical address of the area in which the temporary defect information is recorded ( Fig.6, step 608 for storing position information of defective area, position

information always contains either physical or logical address of the area in which the temporary defect information is recorded. See also figure 9, steps 906, 907, 908 and 909 ), *except to specifically show that* the temporary defect management area comprises positions information of defective area and replacing area. TAKAHASHI from the same field teaches an optical disc includes a temporary defect management area comprises positions information of defective area and replacing area ( paragraph [0129], claims 3 and 4 ). It would have been obvious to someone within the level of skill in the art at the time of the invention was made to use an optical disc of SHIN with the feature as taught by TAKAHASHI as claimed. The rationale is as follows:

It is well known in the optical recording art that the temporary defect management area is used to store information for recovery and/or correcting data, such as, information on position of defective areas, information for replacing defective areas, information of pointers for indicating areas which defective information would be recorded, information about update defective data, etc., these well known features are taught by TAKAHASHI as shown above. Obviously, anyone of ordinary skill in the art at the time of the invention was made would have been motivated to use the defective management areas (DMA1, DMA2, DMA3, DMA4) of SHIN for

storing position information of defective area and replacement area as taught by TAKAHASHI in order to reduce access time during reading process.

Claims 4,5 and 22-24 are rejected with the same reasons set forth in previously Office action.

9) Applicant's arguments with respect to claims *1,4,5 and 22-24* have been considered but are moot in view of the new ground(s) of rejection.

10) The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Applicant is reminded that in amending in response to a rejection of claims ( if the rejection involves with any applicable arts ), the patentable novelty must be clearly shown in view of the state of the art disclosed by the references cited and the objection made. Applicant must also show how the amendments avoid such references and objections. See 37 CFR § 1.111(c).

Form **PTO-892** is attached herein.

11) Any inquiry concerning this communication or earlier communications from the examiner should be directed to **TAN Xuan DINH** whose telephone number is **(571)272-7586**. The examiner can normally be reached on **Monday - Friday from 9:00AM to 5:00PM**.

The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the **Patent Application Information Retrieval (PAIR)** system. Status information for published applications may be obtained from either **Private PAIR** or **Public PAIR**. Status information for unpublished applications is available through **Private PAIR only**. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the **Private PAIR system**, contact the **Electronic Business Center (EBC)** at 866-217-9197 (toll-free).

/TAN Xuan DINH/  
Primary Examiner, Art Unit 2627  
December 20, 2008.